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**APR 12 2010**

**OFFICE OF PETITIONS**

SHERIDAN ROSS PC  
1560 BROADWAY  
SUITE 1200  
DENVER CO 80202

In re Application of	:	
Karl Bruce Thor	:	
Application No. 10/049427	:	DECISION ON APPLICATION
Filing or 371(c) Date: 05/06/2002	:	FOR PATENT TERM ADJUSTMENT
Attorney Docket Number:	:	
4220-78-PUS	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(b), filed July 16, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is 1137 days, not 453 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction based upon an assertion that the Office erred in assessing a reduction associated with the filing of an Information Disclosure Statement ("IDS"), and (2) on the basis that the Office will take in excess of three years to issue this patent.

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), is **GRANTED TO THE EXTENT INDICATED HEREIN.**

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

### BACKGROUND

The application was filed on May 6, 2002. On April 16, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 453 days.

On July 16, 2009, applicant timely submitted the present request for reconsideration of patent term adjustment<sup>1</sup>. Applicants do not dispute the adjustments to date of 964 days (40 days, 159

<sup>1</sup> Office records show that the Issue Fee payment was received in the Office on July 16, 2009.

days or 765 days) or reductions of 240 days (91 days, 28 days, 90 days or 31 days). Applicants, however, assert that the Office erred in assessing a reduction in accordance with 37 CFR 1.704(c)(8) in connection with the Information Disclosure Statement(s) ("IDS"), filed February 28, 2005. Applicants assert that the IDS's were filed in direct response to a telephonic request from the Examiner.

### OPINION

Applicants' arguments have been carefully considered. A review of the record reveals that applicant re-filed copies of IDS's previously filed on June 25, 2002, and April 29, 2003 respectively, noting in the filing that the IDS's were filed at the request of the Examiner. The copies included Certificates of Mailing and return-receipt postcards confirming the prior filing of the IDS's. As such, the IDS's filed February 28, 2005, filed as a supplemental paper within the meaning of 37 CFR 1.704(c)(8), were expressly requested by the Examiner. A review of the application history further confirms that the IDS's were not otherwise filed under circumstances that constitute a failure to engage in reasonable efforts to conclude prosecution. The period of reduction of 271 days entered for the filing of the IDS's is not warranted and is being removed.

With regard to the argument under 37 CFR 1.702(b), knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>2</sup>.

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<sup>2</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on

In view thereof, the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance is seven hundred twenty-four (724) days (adjustments totaling 964 days less reductions totaling 240 days).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods, at (571) 272-3232.



Anthony Knight  
Director  
Office of Petitions

Enclosure: Copy of Revised PALM Screen

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which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Day : Monday  
Date: 4/12/2010

# PALM INTRANET

Time: 06:30:19

## PTA Calculations for Application: 10/049427

Application Filing Date:	05/06/2002	PTO Delay (PTO):	964
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	511
Post-Issue Petitions:	0	Total PTA (days):	724
PTO Delay Adjustment:	271		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
115	04/12/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	271		
104	04/16/2009	MAIL NOTICE OF ALLOWANCE			
103	04/13/2009	ISSUE REVISION COMPLETED			
100	04/11/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
99	04/11/2009	DOCUMENT VERIFICATION			
98	04/11/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
97	04/09/2009	NOTICE OF ALLOWABILITY			
96	02/05/2009	MAIL BPAI DECISION ON APPEAL - REVERSED	765		68
95	02/04/2009	BPAI DECISION - EXAMINER REVERSED			
94	02/03/2009	MAIL BOA MISCELLANEOUS COMMUNICATION TO APPLICANT			
93	02/03/2009	BOA MISCELLANEOUS COMMUNICATION TO APPLICANT			
92	12/15/2008	CONFIRMATION OF HEARING BY APPELLANT			
91	12/02/2008	NOTIFICATION OF APPEAL HEARING			
89	04/23/2008	DOCKETING NOTICE MAILED TO APPELLANT			
88	04/22/2008	ASSIGNMENT OF APPEAL NUMBER			
87	04/02/2008	APPEAL AWAITING BPAI DOCKETING			
86	11/28/2007	MAIL REPLY BRIEF NOTED BY EXAMINER			
85	11/26/2007	REPLY BRIEF NOTED BY EXAMINER			
84	10/18/2007	DATE FORWARDED TO EXAMINER			
83	10/05/2007	REPLY BRIEF FILED			
82	10/05/2007	REQUEST FOR ORAL HEARING			
81	09/27/2007	APPEAL READY FOR BPAI DOCKETING			
80	09/20/2007	MAIL MISCELLANEOUS COMMUNICATION TO			

		APPLICANT			
79	09/13/2007	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
78	09/05/2007	RETURN OF UNDOCKETED APPEAL TO THE TC			
77	09/05/2007	EXAM. ANS. REVIEW COMPLETE			
76	08/10/2007	MAIL EXAMINER'S ANSWER			
75	08/06/2007	EXAMINER'S ANSWER TO APPEAL BRIEF			
74	06/27/2007	DATE FORWARDED TO EXAMINER			
73	05/25/2007	APPEAL BRIEF FILED			
72	04/27/2007	NOTICE -- DEFECTIVE APPEAL BRIEF			
71	04/25/2007	APPEAL BRIEF REVIEW COMPLETE			
70	04/25/2007	DATE FORWARDED TO EXAMINER			
69.1	03/01/2007	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
69	03/01/2007	APPEAL BRIEF FILED			
68	01/03/2007	NOTICE OF APPEAL FILED			
67	10/03/2006	MAIL NON-FINAL REJECTION			
66	09/29/2006	NON-FINAL REJECTION			
65	08/28/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
64.7	08/28/2006	ELECTRONIC INFORMATION DISCLOSURE STATEMENT		31	57
64	08/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
63	07/28/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
62	07/28/2006	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
61	07/28/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
60	07/28/2006	DATE FORWARDED TO EXAMINER			
59	07/28/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
58	07/28/2006	DATE FORWARDED TO EXAMINER			
57	07/28/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
56	07/28/2006	DISPOSAL FOR A RCE / CPA / R129			
55	07/28/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
54.7	07/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

54	07/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
53	07/21/2006	MISCELLANEOUS INCOMING LETTER			
52	06/21/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
51	06/08/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
50	04/04/2006	NOTICE OF APPEAL FILED		90	45
47	04/04/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
46	03/29/2006	CASE DOCKETED TO EXAMINER IN GAU			
45	10/04/2005	MAIL FINAL REJECTION (PTOL - 326)			
44	09/19/2005	FINAL REJECTION			
43	07/08/2005	MISCELLANEOUS INCOMING LETTER			
42.7	07/08/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	40
42	07/08/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
41	07/20/2005	DATE FORWARDED TO EXAMINER			
40	07/08/2005	RESPONSE AFTER NON-FINAL ACTION		28	32
39	07/08/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
38	05/20/2005	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
37	05/19/2005	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
36	05/20/2005	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
35	05/19/2005	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
34	02/28/2005	REFERENCE CAPTURE ON IDS			
33.7	02/28/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		271	23
33	02/28/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
32	03/10/2005	MAIL NON-FINAL REJECTION	159		23
31	03/07/2005	NON-FINAL REJECTION			
30	01/27/2005	CASE DOCKETED TO EXAMINER IN GAU			
29	07/21/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
28	07/21/2004	CORRESPONDENCE ADDRESS CHANGE			

27	07/21/2004	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
26.7	06/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	06/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	06/02/2004	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
24	07/21/2004	DATE FORWARDED TO EXAMINER			
23	06/02/2004	RESPONSE AFTER NON-FINAL ACTION		91	19
22	06/02/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
20	06/02/2004	WORKFLOW INCOMING AMENDMENT IFW			
19	12/03/2003	MAIL NON-FINAL REJECTION			
18	12/01/2003	NON-FINAL REJECTION			
17	09/17/2003	DATE FORWARDED TO EXAMINER			
16	09/15/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
15	08/15/2003	MAIL RESTRICTION REQUIREMENT	40		-1
14	08/15/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
13.7	06/02/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	06/02/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12.7	04/29/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	04/29/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11.7	06/25/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	06/25/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	12/20/2002	CASE DOCKETED TO EXAMINER IN GAU			
9	06/13/2002	APPLICATION DISPATCHED FROM OIPE			
8	06/11/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
7	05/31/2002	NOTICE OF DO/EO ACCEPTANCE MAILED			
6	05/06/2002	ADDITIONAL APPLICATION FILING FEES			
5	05/06/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			

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## **EXPLANATION OF PTA CALCULATION**

## **EXPLANATION OF PTE CALCULATION**

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